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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,054	12/07/2001	Gary A. Ort Merti	14060/249318 (IRC296)	7839
23370	7590	07/15/2005	EXAMINER	
JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/010,054

Applicant(s)

MERTL ET AL.

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 9-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Introduction***

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 5/26/2005. Applicants' amendments to claim 1 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, Applicants' amendment to claim by deleting the term "laminations" overcomes the 35 USC 112, second paragraph rejection in section 5 of Office action dated 3/21/2005.
4. This application contains claims 9-19 drawn to an invention nonelected with traverse (see Office action dated 7/2/2004). A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Rejections Based on Prior Art***

5. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cascino (US 4806404) in view of Cascino (US 5328937), and further in view of Adler et al. (US 3852389), generally as set forth in section 6 of Office action dated 3/21/2005, together with the following additional reasoning and response to argument.

First, for the purpose of clarification, the Examiner repeats the relied upon prior art as follows: Cascino '404 is directed to a self-adherent spacer member for

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positioning between fragile objects, such as glass panels, during shipment. The spacer includes a tack layer (i.e., cling layer) of sufficient adhesive properties to allow the spacer to adhere to the surface of the fragile object without the use of a surface tape (Abstract). In an Example, Cascino '404 teaches that the tack layer is formed from a foamable polyvinyl chloride plastisol, and the tack layer is laminated to a polyethylene foam back cushion layer via an acrylic adhesive (column 1, lines 66-68; column 2, lines 20-30), but any material sufficient to be a backing, and does not scratch glass panels may be used (column 1, line 66 to column 2, line 2). For claim 1, Cascino '404 lacks a teaching that the backing layer (i.e., second layer) is a higher density PVC plastisol foam and the two layers form a single structure without the use of adhesives or other bonding agents, however, it is noted that Cascino '937 is directed to a foam spacer which is usable as a cork substitute in the base cushion layer (i.e., backing layer) of a glass spacer. The spacer is preferably laminated to a tack layer, and is formed from a plasticized foamable resin, such as a PVC plastisol (abstract and column 2, line 49 to column 3, line 3). The foamed PVC plastisol has a density of 25 lbs./ft<sup>3</sup> and having properties similar to natural cork (column 3, lines 8-11). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to substitute the polyethylene back cushion layer of Cascino '404 with a known equivalent backing layer of Cascino '937, i.e., a foamed PVC plastisol, with a cork-like semi-rigid polymeric backing material. It should be noted that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Regarding the bonding between the tack layer

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and the backing layer, it is noted that Adler's invention is directed to a method of making an PVC plastisol foam body by heat foaming a two-layered structure of a first layer of plastisol containing a small amount of blowing agent, and a second layer of plastisol containing a significantly greater amount of blowing agent (column 1, lines 54-63; column 2, lines 48-49). The two layers are fused together to form an integral foam body, i.e., a single structure (column 1, line 50; column 8, lines 13-14). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art of multilayered plastisol foams to modify the teachings of Cascino '404 and Cascino '937 by foaming the two plastisol layers together, as taught by Adler, motivated by the desire to obtain a fused integral foam structure for a strong bonding between the two layers, and a reduced manufacturing cost.

With respect to Applicants' argument "the combination of *Adler* with *Cascino '404* and *Cascino '937* is improper because *Adler* is nonanalogous art and there is no motivation or suggestion to combine these references as suggested by the Examiner" (Remarks, pages 9-10, bridging paragraph), the Examiner notes that *Adler*, *Casicino '404* and *Cascino '937* are all directed to foamable polyvinyl chloride plastisol, as such they are clear<sup>ly</sup> from the same field of endeavor and their teachings are combinable, Applicants' argument to the contrary notwithstanding.

Applicants' argument "*Adler* is nonanalogous art ... is directed to a method of making and shaping foam plastic dolls that have lifelike outer skins, is not in the field of applicants' endeavor, the field of spacers for separating fragile materials" (Remarks, page 10, first full paragraph) has been carefully considered, but is not persuasive. In

response, the Examiner notes that it has been held that the determination that a reference is from a non-analogous art is twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. In re Wood, 202 USPQ 171, 174. In this case, the Examiner notes that while Adler and instant invention are directed to different applications, they are both directed to multilayer foams formed of foamable polyvinyl chloride plastisols, as such they are clearly directed to the same problem, i.e., to obtain a fused integral foam structure for a strong bonding between the two layers, Applicants' argument to the contrary notwithstanding.

With respect to Applicants' argument "Nor is *Adler* reasonably pertinent to the problem with which the inventors were concerned ... *Adler* describes a complex process such that the outer skin of the doll is more lifelike than existing dolls. *Adler* would not have logically commended itself to inventors seeking to solve the problems associated with using cork and cork substitutes in spacers for fragile objects that are described in the background of the present application" (Remarks, page 10, bottom paragraph), the Examiner notes that neither the particular process of Adler, nor cork or cork substitutes are relied upon as basis of the rejection. The Examiner repeats that Adler's teaching is reasonably pertinent to the particular problem with which the inventor was involved, i.e., to obtain a fused integral foam structure for a strong bonding between the two layers, as set forth above.

Similarly, with respect to Applicants' argument "a plastic foam doll toy is not suitable to function as a spacer between fragile objects" (Remarks, page 11, first paragraph), the Examiner repeats that while Adler's invention is directed to a different application, it is Adler's teaching of forming a fused integral foam structure for a strong bonding between the two layers being relied upon as basis of rejection.

With respect to Applicants' argument "*Cascino '404* does not suggest a bonding between the foam layers that provides one with the desire to make a fused integral foam structure" (Remarks, page 12, top paragraph), the Examiner notes that the combined teachings of prior art also inherently renders a simplified process by eliminating the need to use an adhesive layer between the cling and backing layers, and reduces the manufacturing cost, as set forth above.

With respect to Applicants' argument "*Cascino '937* teaches away from bonding the described PVC foam to a foam tack layer because *Cascino '937* describes that the foam is rolled up and sold independently as a cork substitute ... To "fuse" the PVC foam ... to a tack layer as an integral structure ... would limit the potential of the PVC foam to be sold independently as a cork substitute, which would not be desirable" (Remarks, page 12, top paragraph), the Examiner notes that forming a cork substitute for selling independently is irrelevant to the laminated spacer of *Cascino '937*, i.e., they are different subject matter, and it is not seen how *Cascino '937* teaching away forming the laminated structure as a spacer prevents *Cascino '937* making a cork substitute independently, Applicants' argument to the contrary notwithstanding.



Finally, with respect to Applicants' argument "Adler does not provide the requisite motivation either, as its chief objective is to achieve a lifelike outer skin for a foam doll using a mold" (Remarks, page 12, bottom paragraph), the Examiner notes that Applicants clearly argue the cited references individually. In response to Applicant's argument, it is asserted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. In particular, the combined teachings of Cascino '404, Cascino '937 and Adler renders the instant invention obvious as claimed, as set forth above, Applicants' argument to the contrary notwithstanding.

6. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cascino (US 4806404) in view of Cascino (US 5328937), or further in view of Adler et al. (US 3852389) and Lerman (US 3616029), generally as set forth in section 7 of Office action dated 3/21/2005, together with the additional reasoning as set forth above.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*VSC*  
Victor S Chang  
Examiner  
Art Unit 1771

6/28/2005

  
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